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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/716,848	11/17/2000	Thomas J. Perkowski	100-058USA000	9618

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EXAMINER

CARLSON, JEFFREY D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/716,848

Applicant(s)

PERKOWSKI, THOMAS J.

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 418-460 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 418-460 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the paper(s) filed 6/5/06.

Information Disclosure Statement

2. Applicant refers to a supplemental IDS, yet no such document has been located in the file.

Double Patenting

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claims 446-460 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 432-445. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in

wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 419-460 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 418 finishes with language regarding a tag installed in an HTML document, yet there are no HTML documents positively claimed. Indeed the claim refers to tags that are part of the claimed apparatus, yet the tags are only *capable* of being embedded; it does not appear that applicant intends to claim the documents themselves as part of the apparatus, yet the end of claim 418 appears to contradict this.
- Claim 427, it is unclear how the tag can be embedded into an image, product document or graphical icon.
- Claim 429 describes the step of how the items are imported in to the network, yet the claims are apparatus claims, not method claims. It is not clear what applicant is further structurally imitating by this claim.

- Because claims 432-445 and claims 446-460 appear to be repetition of claims 418-431, the claims given 112 rejections herein also apply to the associated claims repeated within 432-460.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 418-460 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stern (US6591247) in view of Durst, Jr. et al (US6542933).**

9. Regarding claim 418, 420-422, 427, 430, 431 Stern teaches systems and methods for providing networked, in-store kiosks that can be used to deliver product information and advertisements. A centralized server (NMC/NOC 12/20) receives various types of content (ads, information, audio, video, etc) and makes the content available to various stores [fig 1]. Each store has plural kiosk sites 30 including a video screen, keyboard and light pen. The kiosks and servers are connected by way of IP protocol and/or the Internet [4:46-68]. A consumer can scan the UPC barcode (Universal product number UPN) of a product at the kiosk and receive advertising and other information about the product [6:46-50, 7:14-17, 27-32, 48-50] which provides a positive brand experience. Stern teaches that the central database provides a UPC-indexed database of products that stores the relationship (via the tblUPCmaster table)

between the UPC codes and the associated content (ads, information, audio, etc) associated with that product [8:10-25]. The UPC codes of Stern are taken to be equivalent to applicant's UPN in that they both provide an item identifier to be used for database lookups to retrieve and deliver advertising and item information. Stern teaches that functionality is provided to input ads/information into the system [6:1-34] which is taken to represent programming of the various information modes. Stern teaches that a management user interface is provided for viewing and creating the tables in the database which determine the content and content delivery mechanisms for the kiosks. It is unclear whether management workers must interface the system locally or remotely. However, Stern teaches a distributed system of complex subsystems which communicate over various networks including the Internet and it would have been obvious to one of ordinary skill at the time of the invention to have provided the management user interface as a web-enabled interface (remote GUI) in order for any remotely located manager to access and program the system. The display of ads and information to the requesting user about the requested item is taken to provide a virtual kiosk that displays advertisements and information which are taken to promote the item. Any web page displaying any content about the requested item is taken to be a "virtual kiosk." Durst, Jr. et al also teaches a means for a consumer to scan a barcode (at a kiosk [8:1-3]) in order send a request to a centralized server for more information about the item scanned. Durst, Jr. et al teaches that the item identification/barcode is scanned into the a web browser and sent to the server. The server links the user to the URL of the associated information [3:15-30, 66-67].

Although any advertisement content delivered through an advertising mode is taken to promote the item advertised, therefore providing a promotion and promotion mode, Durst, Jr. et al teaches product descriptions as well as product promotions [col 23 lines 7-29]. It would have been obvious to one of ordinary skill at the time of the invention to have provided a mode for displaying product promotions as well Stern's displaying advertising mode and product information mode in order to provide more brand awareness and encourage the consumer to purchase a particular brand. Stern does not appear to provide the dynamic web application (UPC-specific information) with the use of embedded "tags" in the HTML web pages. Durst, Jr. et al however does teach that a web-based product information system can be provided by use of a Java servlet located at the server [col 6 lines 47-49]. It is taken to be inherent that provision of a JAVA servlet is accompanied by the necessary <tags> embedded in the web documents that are to provide the server functionality when the user desires to interact with the server to obtain the requested information. It would have been obvious to one of ordinary skill at the time of the invention to have provided access to the interactive server processes of Stern using embedded tags that point to the proper JAVA servlets in a manner as taught by Durst, Jr. et al.

10. Regarding claims 419, 423-426, the system of Stern is taken to provide management with a means (subsystem) for creating the necessary links/indexes/keys of UPN/TM/PD to the associated content in the databases. Official Notice is taken that URL links are well known to include icons and/or link text. It would have been obvious to one of ordinary skill at the time of the invention to have labeled the provided links with

such items in order to describe the link to the user for clarity. Further, Stern teaches providing ads, audio, video and information about the item. Durst, Jr. et al teaches providing product and other types of information about products. It would have been obvious to one of ordinary skill at the time of the invention to have returned a list of URL links to the user when the product requested is associated with plural content files (ads, promotions, information, warranty, etc), so that the user may choose which content to review.

11. Regarding claim 428, it is not believed that applicant has positively claimed the HTML documents, but rather merely the servlet capabilities and possession of tags that *can be inserted* into HTML documents. The same is true with the combination proposed. Further however, Stern teaches that the site having the kiosk can also include e-commerce access [5:52].

12. Regarding claim 429, the UPN/TM/PD are taken to be present in the combination as proposed, however the manner in which the data is initially introduced or created (whether through an import process or otherwise) cannot be set forth in a system/apparatus claim.

13. Claims 432-460 are repetitions of the same concepts as in claims 418-431 and are rejected with the same reasoning.

Response to Arguments

14. Applicant present new claim language and arguments that focus on a bifurcated approach of providing a server-side component and embedded tag referring to the

server-side component. Examiner points to and relies upon the teaching by Durst, Jr. et al to deploy the interactive product look-up system using a JAVA servlet [at least at col 6 lines 47-49] as the basis for the present art rejection.

15. Applicant presents several arguments for allowability which are narrower than the present claim scope. For example, rich media can be hosted on the Akamai CDN, and Stern is unsuitable for use in the market spaces existing along both electronic and physical streams of commerce.

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-

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6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc